

**AMENDMENTS TO THE DRAWINGS**

Please amend the figures as shown in the enclosed replacement sheets. The attached sheet(s) of drawings includes changes to Figures 6-13 to indicate prior art.

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for indicating that claim 1 is allowable and for indicating that claim 5 contains allowable subject matter.

**Disposition of Claims**

Claims 1-5 were pending in this application. By way of this reply, claim 6 has been added. Accordingly, claims 1-6 are now pending in this application. Claims 1 and 2 are independent. The remaining claims depend, directly or indirectly, from claim 2.

**Claim Amendments**

Independent claim 2 has been amended to clarify that spacer portions are folded upward from the ends of the bottom housing portion, to clarify the formation of an opening and a folding portion, and to correct minor errors. No new subject matter has been added by way of the amendments to claim 2, as support for these amendments may be found, for example, in Figure 2 of the present application and in paragraph [0036] of the publication of the Specification. Further, dependent claims 3-5 have been amended to correct minor errors. No new matter has been added by way of the amendments to claims 3-5.

**Objection(s)**

The drawings are objected to for not being designated by a legend such as "Prior Art." The drawings have been amended in this reply to show a "Prior Art" legend for Figures 6-13. Accordingly, withdrawal of the objection to the drawings is respectfully requested, and Applicant respectfully requests that the Examiner accept the formal drawings.

**Rejection(s) under 35 U.S.C. § 112**

Claims 2-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 2-5 have been amended in this reply as discussed above. To the extent that the rejection may still apply to the claims as amended, the rejection is respectfully traversed.

As amended, independent claim 2 is directed to a corrugated-cardboard packing member adapted to be adjacent to a pair of holding members for holding a first article arranged within a corrugated cardboard box. Although the holding members and the corrugated cardboard box are recited in the preamble of the claim for context, Applicant confirms that claim 2 is directed to the sub-combination of the corrugated cardboard packing member.

Amended independent claim 2 requires, in part, an opening formed by cutting a predetermined area from the bottom housing portion and folding the predetermined area downward, forming a folding portion, where the folding portion is arranged between the pair of holding members. Thus, it is clear that an opening is formed by cutting a predetermined area from the bottom housing portion and folding the predetermined area downward, forming a folding portion. Said another way, the predetermined area becomes the folding portion when it is folded downward. Applicant respectfully asserts that amended independent claim 2 clearly requires an opening, while the addition of new claim 6 (discussed below) differentiates a second opening from the opening recited in amended independent claim 2. Accordingly, independent claim 2, as amended, particularly points out and distinctly claims the subject matter which Applicant regards as the invention, and withdrawal of the § 112, second paragraph, rejection is respectfully requested.

**Rejection(s) under 35 U.S.C. § 102**

Claim 2 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,398,808 issued to Chen *et al.* ("Chen"). Independent claim 2 has been amended in this reply as discussed above. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

One or more embodiments of the present invention are directed to a corrugated cardboard packing member. As seen with respect to Figures 2 and 3 of the Specification, a corrugated cardboard packing member **20** in accordance with one or more embodiments of the invention has two spacer portions **22** folded upward from bottom housing portion **21** (*see, e.g.*, publication of the Specification, Figures 2 and 3, paragraph [0036]). Spacer portions **22** are arranged in a gap between an upper surface of a pair of holding members and an inner surface of a corrugated cardboard box (*see, e.g.*, publication of the Specification, paragraph [0036]).

Accordingly, amended independent claim 2 requires a pair of spacer portions, each spacer portion folded upward from a respective end of said bottom housing portion and arranged in a gap between the upper surface of the pair of holding members and the inner surface of the corrugated cardboard box.

Chen, in contrast to amended independent claim 2, does not disclose at least the above limitations of the claimed invention. Further, Chan fails to show or suggest at least the above limitations of the claimed invention. In contrast to the invention, Chen is directed to a buffer device having a base frame **2** and supporting frames **3** (*see* Chen, Figures 1, 2, col. 3, line 63 – col. 4, line 12). It would be clear to one skilled in the art that Chen does not show or suggest at least a pair of spacer portions folded upward from the ends of the bottom housing portion, as required by the claimed invention. In contrast, it would be clear to one skilled in the art that the buffer device of Chen is formed from several separate cardboard components that are

folded and assembled together. Thus, Chen does not show or suggest at least the above limitations of amended independent claim 2.

Further, it would be clear to one skilled in the art that the side wall panels **22** and side wall reinforcing panels **23** of Chen are part of a base frame **2**, which holds an article (*i.e.*, a product). Thus, rather than the spacer, the side wall panels **22** and side wall reinforcing panels **23** of Chen hold an article. In fact, as seen, for example, in Figure 1 of Chen, base frames **2** hold a product **P**, and are supported by supporting frames **3** that are joined to the base frames **2** (*see, e.g.*, Chen, Figure 1, col. Col. 2, lines 4-6). Thus, it would be clear to one skilled in the art that Chen fails to teach or suggest a pair of spacer portions are “arranged in a gap between the upper surface of the pair of holding members and the inner surface of the corrugated cardboard box,” as required by the claimed invention.

In view of the above, Chen fails to show or suggest the invention as recited in amended independent claim 2. Thus, amended independent claim 2 is patentable over Chen. Accordingly, withdrawal of this rejection is respectfully requested.

#### **Rejection(s) under 35 U.S.C. § 103**

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being obvious over Chen. Independent claim 2 has been amended in this reply as discussed above. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As discussed above, one or more embodiments of the present invention are directed to a corrugated cardboard packing member. Further, as discussed above, amended independent claim 2 requires a pair of spacer portions, each spacer portion folded upward from a respective end of said bottom housing portion and arranged in a gap between the upper surface of the pair of holding members and the inner surface of the corrugated cardboard box. Further,

as discussed above, Chen does not show or suggest at least the above limitations of the claimed invention.

Further, Applicant respectfully asserts that the Examiner's argument that the orientations of the cores of the cardboard would be a design choice to provide more stability to the package finds no support in Chen. In fact, Chen is completely silent with respect to the orientations of the cores of the cardboard. One result of the claimed configuration of spacer portions 22 of the corrugated-cardboard packing member 20 is that spacer portions 22 are difficult to bend in the vertical direction as compared with those of the conventional spacer portions, for example, when subjected to a drop or other force (*see, e.g.*, Specification as published, paragraph [0038]).

Further, the Examiner's position directly contrasts the disclosure present in Figures 11 and 12 and in paragraph [0008] of the publication of the Specification. Thus, such a configuration of the orientation of the cores is not merely a design choice, as asserted by the Examiner. It appears that the Examiner is relying on personal knowledge clearly not present in or taught by Chen to form part of this rejection. To the extent that the Examiner is relying on personal knowledge as the basis of this rejection, the Applicant respectfully requests that the Examiner, pursuant to 37 C.F.R. §1.104(d)(2), supply a declaration setting forth specific factual statements and explanation to support such a finding.

In view of the above, Chen fails to show or suggest the invention as recited in amended independent claim 2. Thus, amended independent claim 2 is patentable over Chen. Claims 3 and 4, directly or indirectly dependent from claim 2, are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

#### **New Claim**

By way of this reply, new claim 6 has been added to specify a second opening formed by cutting a second predetermined area from the bottom housing portion and folding the second predetermined area downward, forming a second folding portion, where the second folding portion is arranged between the pair of holding members. No new matter has been added by way of new claim 6, as support for new claim 6 is present, for example, in Figure 2 of the Specification. New claim 6 depends from claim 2. As claim 2 has been shown above to be allowable, claim 6 is allowable for at least the reasons discussed above with respect to claim 2.

### Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04995/142001).

Dated: November 30, 2006

Respectfully submitted,

By 

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Attachments (Drawings)